

REMARKS

Applicant appreciates the Examiner's thorough examination of the present application as evidenced by the Office Action. Applicant further appreciates the Examiner's indication that Claims 12-14 are allowed and that Claim 4, 9, 18, and 19 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1, 8, and 16 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,768,393 to Song. Claims 2, 3, 5-7, 17, and 20-22 stand rejected under 35 U.S.C. 103(a) as obvious over Song in view of applicant's admitted prior art (APA) in Fig. 1. Applicant amended Claim 1 to include the recitations of Claim 6, and submit that all of the independent claims are patentable for at least the following reasons.

Song is not prior art under 35 U.S.C. 103(c) because Song and the present application are commonly owned and the present application was filed after November 29, 1999.

In particular, the present application claims priority to Korean Patent Application No. 10-2203-0018471, filed on March 25, 2003 in the Korean Intellectual Property Office. The publication date of Song is June 26, 2003. Accordingly, Song is a 102(e) reference relative to the present application, as acknowledged by the Office Action in its rejection of Claims 1, 8, and 16.

Song cannot be properly used in a rejection under §103 because the present invention and Song were commonly owned by Samsung Electronics Co., Ltd. at the time that the present invention was made. Accordingly, § 103(c) removes Song as a reference.

In particular, §4807 of the American Inventors Protection Act of 1999 (AIPA) amended §103(c) to recite:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of Section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

§4807 further states that the amendment shall apply to any application for patents filed on or after the date of the enactment of this act (November 29, 1999). S 1948 I.S. §4807.

Accordingly, as Song and the present application were commonly owned at the time that the

present invention was made, Song cannot be relied on as prior art in an obviousness rejection of the present application because the present application was filed on February 17, 2004 (*i.e.*, after November 29, 1999). Thus, the rejection of Claims 2, 3, 5-7, 17, and 20-22 under § 103 should be withdrawn.

Applicant has amended Claim 1 to include the recitations of Claim 6 which is patentable over Song in view of APA. Claim 6 has been canceled. Because Song is not prior art under 35 U.S.C. 103(c), Applicant requests that the rejections of Claim 1 and Claims 2-5 and 7-9, which depend from Claim 1, be withdrawn.

Claim 16 has been amended to correct a typographical error so as to change "terminal circuit" to "termination circuit". Independent Claim 16 now recites in part:

an on-chip termination circuit that is configured to generate a variable resistance to an input signal based on a first code signal, wherein the on-chip termination circuit comprises a termination resistor that is configured to generate the variable resistance to the input signal based on the first code signal;

Accordingly, Claim 16 recites that the semiconductor device includes an on-chip termination circuit that includes a termination resistor that is configured to generate the variable resistance to the input signal based on the first code signal. Applicant notes that the above underlined recitation of Claim 16 is the same as that of original Claim 6, now included in amended Claim 1.

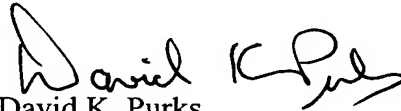
The Office Action stated on Page 5 with regard to Claim 6 that "Song teaches all claimed features [of] the semiconductor device of Claim 1; with the exception of teaching wherein the on-chip terminal circuit comprises a termination resistor that is configured to generate a variable resistance to the input signal based on a first code signal." Accordingly, the Office Action concedes that the above-underlined recitation of Claim 16 is not disclosed by Song. Consequently, Song cannot anticipate Claim 16 under 35 U.S.C. 102(e) because Song does not disclose at least the above-underlined recitation of Claim 16. Because Song is not prior art under 35 U.S.C. 103(c), Applicants request withdrawal of the rejection of Claim 16. Dependent Claims 17-22 are submitted to be allowable per the allowability of independent Claim 16.

Accordingly, Claims 1-5, 7-9, 12-14, and 16-22 are submitted to be in condition for allowance.

In re: Seong-Jin Jang
Serial No.: 10/780,057
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If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is encouraged to contact the undersigned by telephone at (919) 854-1400.

Respectfully submitted,

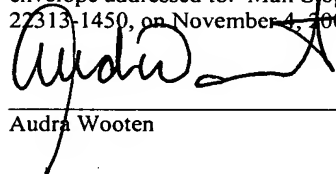


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 4, 2005.


Audra Wooten